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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,848	06/25/2003	Thomas Fichter	FICHTER	5539
29281	7590	04/07/2004	EXAMINER	
JAMES D. PETRUZZI 4900 WOODWAY SUITE 745 HOUSTON, TX 77056			FISCHMANN, BRYAN R	
			ART UNIT	PAPER NUMBER

3618

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/603,848	FICHTER, THOMAS	
	Examiner	Art Unit	
	Bryan Fischmann	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The specification is objected to because of the following:

A) It is requested Applicant update the status of application 10/041,273 on line 5 of page 2 to indicate that this application is now US Patent 6,588,783.

Claim Objections

2. Claims 1-9 are objected to because of the following:

A) Claim 1 recites wherein said bar is positioned along the longitudinal axis of the vehicle.

The words "the longitudinal axis" in the above recitation is objected to, as there are theoretically an infinite number of "longitudinal axes" of the vehicle. If one were to narrow the number of longitudinal axes to one, the one "longitudinal axis" would most likely be the longitudinal axis through the center of gravity of the vehicle, which is not the same longitudinal axis as the longitudinal axis that passes through the side bar in claim 1. Therefore, it is suggested that the words "the longitudinal axis" in the above phrase be changed to "a longitudinal axis", or "parallel to the longitudinal axis".

See also a similar recitation in claims 8 and 9.

B) Claim 1 recites "one or more smaller U-shaped cylindrical bars comprised of two end portions and a center portion fixedly attached to said side bar".

This recited phrase is objected to, as it may be literally interpreted that the "center portion" is fixed attached to the side bar, which, of course, is not actually the

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case. Compare to wording in claim 9 which make clear that the "end portions" of the U-shaped bar is attached to the side bar and not the center portion.

See also a similar recitation in claim 8.

C) The recitation of "said bar" in the third to last line of claim 8 is objected to, as the claim has previously recited both "side bar" and "cylindrical bar", potentially leaving unclear which bar is being referred to by the recitation of "said bar". As best understood, the recitation of "said bar" is intended to be "said side bar". Compare to similar wording in claim 1.

See also a similar objectionable recitation in claim 9.

D) Though perhaps not strictly objectionable, the recitation of "center bar" in lines 4 and 7 of claim 9 is not considered preferred wording, since the "center bar" is actually a "portion" of the U-shaped bar, and not a separate bar, as the recitation of "center bar" may imply. Note that the term "center bar" was instead termed "center portion" in claims 1 and 8.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regards as his invention.

A) Claim 1 recites the limitation "said center bar". There is insufficient antecedent basis for this limitation in the claim.

See also a similar recitation in claim 8.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent 210465, in view of Graffy, et al, US Patent 5,732,996.

European Patent 210465 teaches an apparatus for assisting entry (see comments below) into high road clearance vehicles comprising:

a generally cylindrical side bar (1) adapted for attachment for horizontal attachment to a vehicle wherein said bar is positioned along the longitudinal axis of the vehicle (when pivoted inward – see Figure 2);

one or more smaller U-shaped cylindrical bars (10) comprised of two end portions and a center portion fixedly attached to said side bar.

European Patent 210465 fails to teach a generally flat surface on the top of each of said center bar of said U-shaped bars.

However, Graffy teaches a U-shaped cylindrical bar (12) with a generally flat surface (59) on the top of the center portion of the U-shaped bar. A flat surface on the top center portion of the U-shaped bar is advantageous in that if the flat surface was not

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there, when a user places his foot on the round bar, the round shape leaves the potential for sliding-off the bar, particularly if the bar is wet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a flat surface on the center portion of the U-shaped bar of European Patent 210465, as taught by Graffey.

Regarding claim 2, the Examiner takes Official Notice that it is known to one of ordinary skill in the art to weld bars to each other. This may be seen on the frame of automobiles, running boards, or roll bar assemblies of pick-up trucks, or sport utility vehicles. Welding is advantageous in that the bars are easily connected to each other, without the use of fasteners, which require holes to be drilled and tools to install the fasteners.

Regarding claims 6 and 7, the "angle" is selected to be 0 degrees.

Regarding the claim 1 and 8 limitation "for assisting entry into high road clearance vehicles", it is noted this limitation is functional language. The functional recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. In re Casey, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967). It is the Examiner's position that the prior art is capable of performing the recited functions, as the apparatus, when pivoted outward is proximal the vehicle door and is capable of assisting entry into the vehicle through the door.

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Once this prima facie case has been established, the burden shifts to the applicant to show that the prior art structure does not possess the functionally defined limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1-3 and 5-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,588,783.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the Instant Application identified above and claim 1 of US 6,588,783 each claim the same basic structure, namely a generally cylindrical side bar, at least one smaller U-shaped generally cylindrical bar attached to the side bar, and a generally flat surface on the top of the center portion of the U-shaped bar.

Allowable Subject Matter

9. Claim 4 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and to overcome any applicable claim objections.

10. Claim 9 would be allowable if rewritten or amended to overcome the claim objection set forth in this Office action.

Reasons for Allowance

11. The following is an Examiner's statement of reasons for allowance of independent claim 9:

Claim 9 recites the limitation (as paraphrased) of an apparatus to enable access into a vehicle comprising a generally cylindrical side bar positioned along a longitudinal axis of the vehicle, a generally U-shaped bar fixedly attached to said side bar, wherein said U-shaped bar is attached at an angle of approximately 45 degrees from the horizontal plane. This limitation, in combination with the other limitations of claim 9, were not found in the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mitchell, Sheridan, Jackson, Sidles, Jr., Barbour, Kelly, Straka, Albrecht and EP 0173227 – teach a vehicle step

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 4-4-4
BRYAN FISCHMANN
PATENT EXAMINER